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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,982	12/20/2001	Joel C. Barrish	QA0238 NP	1428

23914 7590 11/05/2002

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EXAMINER

ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 11/05/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/027,982

Applicant(s)

BARRISH ET AL.

Examiner

Rebecca L Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-19 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 7-14 and 16-19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: \_\_\_\_\_

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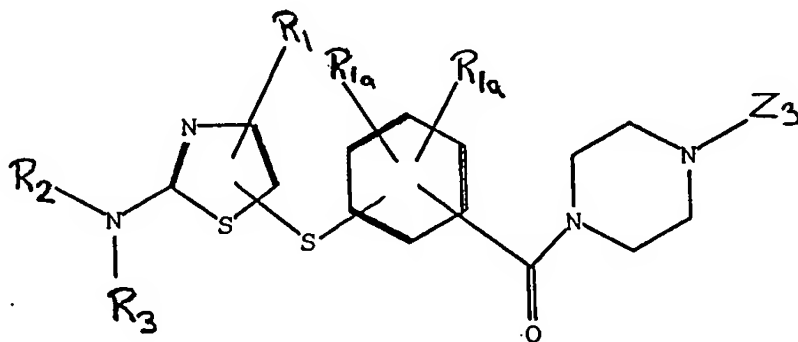
**DETAILED ACTION**

Claims 7-19 are currently pending in the application. Claims 7, 9 and 17 were amended in Paper No. 7, filed 9 August, 2002. Claim 15 is withdrawn from consideration as being drawn solely to non-elected subject matter.

***Election/Restrictions***

The subject matter of claims 7-19 other than that wherein:

The compound of formula I with the following structure



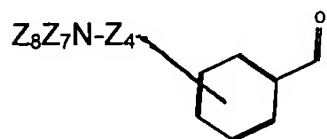
wherein:

$Z_3$  is  $C(O)R_6$ .

$R_1$  is hydrogen, or  $R_6$ .

$R_{1a}$  is hydrogen,  $R_6$ , or  $-OR_6$ .

One of  $R_2$  or  $R_3$  is hydrogen, or  $-Z_4-R_{6a}$  wherein  $Z_4$  is a single bond and the other is



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wherein **Z<sub>4</sub>** is alkyl and **Z<sub>7</sub>** and **Z<sub>8</sub>** are hydrogen, or  $-Z_4-Z_{6a}$  wherein **Z<sub>4</sub>** is a single bond and **Z<sub>6a</sub>** is alkyl.

**R<sub>6</sub>** and **R<sub>6a</sub>** are alkyl.

Looking at the formula in claim 1 in reference to the above formula:

**Q<sub>1</sub>** is thiazolyl.

**Z** is  $-S-$

**Q<sub>2</sub>** is phenyl (substituted by the depicted **Z<sub>3</sub>** substituted piperazinyl carbonyl group), stands withdrawn under 37 CFR 1.142(b) as being for non elected subject matter, for reasons essentially those given in the last Office action. Applicants' traversal of the restriction requirement has been considered but is not found persuasive. Applicants argue that the examiner has not examined the elected claims as required by MPEP 803.02 and has improperly refused to examine that which the applicants regard as their invention by withdrawing subject matter from claims 7-19. Applicants also argue that the claims do not lack unity of invention.

Firstly, it is pointed out that the restriction requirement is made under 35 U.S.C. 121. 35 U.S.C. 121 gives the Commissioner (Director) the authority to limit the examination of an application where two or more independent and distinct inventions are claimed to only one invention. The examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted (limited) claimed subject matter accordingly. Thus the requirement to restrict the claims in this application is predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. Nowhere do applicants argue to the

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contrary. Nowhere do applicants point out and give reasons why the claims do not involve independent or distinct subject matter. Rather, applicant has argued a lack of unity standard, which does not address the premise of the restriction requirement. Notwithstanding that lack of unity is not the basis for this restriction requirement, a lack of unity standard requires that the claims contain a special technical feature that defines a contribution over the art. Here the claims contain a 2-disubstituted amino-5-phenylthiothiazole group that does not define a contribution over the art as there are numerous references, which contain such a group. (Note the extensive list of references on form 1449). So, here we have claims, which involve more than one independent or distinct invention. Under 35 U.S.C. 121, the claims may be restricted and the examination limited to a restricted invention. There is no argument or evidence to the contrary. Accordingly, restriction as has been presented in this application is proper. The requirement to restrict is repeated and made final.

### ***Objections***

Claims 7-14 and 16-19 are objected to as containing non-elected subject matter. Claims 7-14 and 16-19 presented drawn solely to the elected invention as identified supra would appear allowable.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


### **Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.

  
\_\_\_\_\_  
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Art Unit 1626, Group 1620

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